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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/176,274 10/21/98 OHSHIMA

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005514 WM02/1109  
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EXAMINER

BRIER, J

ART UNIT

PAPER NUMBER

2672  
DATE MAILED:

11/09/01

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/176,274	OHSHIMA ET AL.
Examiner	Art Unit	
Jeffery A. Brier	2672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 15 October 2001.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-40 is/are pending in the application.

4a) Of the above claim(s) 12-14, 26-28 and 30-40 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-5, 11, 15-19, 25 and 29 is/are rejected.

7) Claim(s) 6-10 and 20-24 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 10/21/98 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION*****Response to Election***

1. Applicant's election with traverse of the restriction requirement in Paper No. 8, mailroom stamp data of 10/15/01, is acknowledged. The traversal is on the ground(s) that:

An application may be properly required to be restricted to one of two or more claimed inventions only if the inventions are able to support separate patents and they are either independent or distinct. MPEP § 803. If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP § 803.

"The term 'distinct' means that two or more subjects as disclosed are related, for example, as combination and part (sub-combination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed and are patentable (novel and unobvious) over each other (though they may each be unpatentable because of the prior art)." MPEP § 802.01. In this regard, Applicants respectfully submit that the claims of Groups I, II and III are all directed to document graphic editing and graphic formatting. Accordingly, two-way distinctness is not seen to be present among the claims of Groups I, II and III. MPEP § 806.05(c). Even if Groups I, II and III are considered to be independent or distinct inventions, which Applicants do not admit to be the case, the search and examination of all pending claims of Groups I, II and III can be made without serious burden, and therefore restriction is improper. MPEP § 803. Specifically, the claims of Groups I, II and III are all directed to document graphic editing and graphic formatting. Accordingly, Applicants respectfully submit that concurrent search and examination of all claims of Groups I, II and III can be made without serious burden.

Based on the foregoing remarks, Applicants respectfully submit that the restriction requirement is improper and therefore request reconsideration and withdrawal of the restriction requirement. Accordingly, Applicants request concurrent examination of all currently-pending claims of Groups I, II and III.

This is not found persuasive because the groups identified by the previous examiner require different searches which place a serious burden on any one Examiner to search. Applicant contends that "the claims of Groups I, II and III are all directed to document graphic editing and graphic formatting". This contention is not agreed with because Groups I, II, and III claim different inventions that require different classification

searches and different text database searching. The following side by side comparison of claims 1, 12, and 31 should make it very clear that each group is claiming an invention that requires a different search. Text underlined indicates parts of the claims which distinguish that group from the other two groups.

Group I Claim 31	Group II Claim 1	Group III Claim 12
An image processing apparatus capable of variable magnification processing of output information, comprising:	An image processing apparatus capable of variable magnification processing of output information, comprising:	An image processing apparatus for rendering an object set generated by document processing means for processing a character and figure or image processing means for processing an image, the object set being formed by more than one objects, <u>each object having an attribute for rendering which is associated with a mapping method upon changing a size of the object, and can be individually set</u> , said apparatus comprising:
		<u>edit means for editing the objects that form the object set;</u>
		rendering means for rendering based on attributes in units of objects;

instruction means for instructing simultaneous variable magnification processing of a <u>specific region</u> ;		
	holding means for holding output images in a first size and output positions thereof, and holding output images in a second size and output positions thereof;	
and changing means for <u>changing a layout without changing a size of a character</u> itself in the specific region when said instruction means instructs the variable magnification processing of the specific region in one of vertical and horizontal directions, and <u>changing the size of the character itself without changing the layout</u> when said instruction means instructs the variable magnification processing of the specific region in both the vertical and horizontal directions.	selection means for selecting a desired image from the output images held by said holding means, and designating an output size of the selected image;	changing means for changing a size of the object set;
	generation means for generating an output image corresponding to the output size <u>on the basis of a ratio of change in output image between the first and second sizes</u> held by said holding means of the image selected by said selection means;	generation means for generating new size information of the object set in correspondence with the change in size by said changing means; and

	<p>determination means for determining a rendering position of the output image corresponding to the output size <u>on the basis of a ratio of change in output position between the first and second sizes</u> held by said holding means of the image selected by said selection means; and</p> <p>rendering means for rendering the output image generated by said generation means at the rendering position determined by said determination means.</p>	<p>determination means for <u>determining a new rendering attribute of each object</u> on the basis of the rendering attribute of each of the objects that form the object set in accordance with the size information generated by said generation means,</p> <p>said rendering means <u>rendering on the basis of the rendering attributes of the objects</u> determined by said determination means.</p>
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The statements made by the previous examiner in the restriction requirement regarding different searches and different classifications are correct. The restriction requirement stated:

1.      Restriction to one of the following inventions is required under 35 U.

S. C. 121:

- I.      Claims 31-40, drawn to a method for layout of a document, classified in class 707, subclass 517.
- II.     Claims 1-11, 15-25, and 29, drawn to a method for computer graphic manipulation process, classified in class 345, subclass 666.
- II.     Claims 12-14, 26-28, and 30, drawn to the editing and controlling the object's size, classified in class 345, subclass 665.

2.      Inventions I, II, and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed require neither the particulars of the subcombination as

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claimed because the layout of a document does not require the rendering of the object based on the size of the output image, nor the editing and controlling object's size. The subcombination has separate utility such as graphic manipulation based on object, and editing the object's size.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, or Group III, restriction for examination purposes as indicated is proper.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The requirement is still deemed proper and is therefore made FINAL.

### ***Drawings***

2. Figure 18 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-5, 11, 15-19, 25, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomson, U.S. Patent No. 5,682,487. Thomson describes resizing windows that contain a view of a network device. As shown in figures 5-7 different sizes of windows may be selected by the user. At column 5 line 28 to column 6 line 51 it is clear that different sizes of windows are stored in a holding means. At column 6 lines 43-46 it is clear that for sizes between the stored sizes an interpolation is performed between two stored sizes. Interpolating uses the ratio between two known values to determine the desired value.

Claim 1:

Thomson teaches an image processing apparatus capable of variable magnification processing of output information (100%, 66%, 33%, 75%, etc.), comprising: holding means for holding output images in a first size and output positions thereof, and holding output images in a second size and output positions thereof (column 6 lines 9-13); selection means for selecting a desired image from the output images held by said holding means, and designating an output size of the selected image (column 5 lines 60-64, column 6 lines 36-46); generation means for generating an output image corresponding to the output size on the basis of a ratio of change in output image between the first and second sizes held by said holding means of the image selected by said selection means (at column 6 lines 41-46 interpolation between the stored sizes is performed to determine the output image for the selected size); determination means for determining a rendering position of the output image

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corresponding to the output size on the basis of a ratio of change in output position between the first and second sizes held by said holding means of the image selected by said selection means (in figures 5-7 Thomson shows that different sized windows are displayed at different locations); and rendering means for rendering the output image generated by said generation means at the rendering position determined by said determination means (the interpolation step renders the output image and places it at position determined for that size of window).

Claim 2:

Thomson teaches the apparatus according to claim 1, wherein said selection means selects the image from the output images in the first size held by said holding means (column 5 lines 60-64, column 6 lines 36-46).

Claim 3:

Thomson teaches the apparatus according to claim 1, wherein said rendering means renders the output image generated by said generation means on a display screen of a display device (Display Device 121, column 3 lines 6-12).

Claim 4:

Thomson teaches the apparatus according to claim 3, further comprising output means for outputting rendering information of said rendering means to an output device which permanently visually displays the rendering information in units of pages (hard copy device 124, column 3 lines 25-28).

Claim 5:

Thomson teaches the apparatus according to claim 1, wherein said rendering means renders the output image generated by said generation means as print information to a printing apparatus (hard copy device 124, column 3 lines 25-28).

Claim 11:

This claim is described in applicants specification at page 6 lines 7-15, page 22 line 1 to page 23 line 21.

Thomson teaches the apparatus according to claim 1, wherein a moving amount of a rendering position of the output image corresponding to the ratio of change in output position of the output image between the first and second sizes is compressed in the vicinity of an edge portion of an outputtable range so as to prevent the rendering position from falling outside the outputtable range of an output device upon movement of the rendering position determined by said determination means for the output image selected by said selection means (In Thomson, as the window is compressed or resized smaller, the objects in the window near an edge, as well as objects at other locations

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within the window, are compressed, this is seen by comparing figures 6 and 7 where the symbols, including the ones at the edges, have been shrunk and displayed). This claim does not exclude that which is shown to be old and well known by the Thomson reference since claim 1 is a comprising claim and claim 11 is a comprising claim by reference to claim 1 and due to the absence of limitation excluding performing position compression at locations other than the edges.

Claims 15-19 and 25 :

Claims 15-19 and 25 are method claims corresponding to apparatus claims 1-5 and 11. The only difference being the style of the claims. The functions of claims 1-5 and 11 are the same functions performed in claims 15-19 and 25. Claims 15-19 and 25 are rejected for the same reasons that claims 1-11 are rejected.

Claim 29:

Claim 29 is computer-readable memory claim corresponding to apparatus claim 1 and method claim 15. The only difference being the style of the claims. The functions of claims 1 and 15 are the same functions performed program stored in the computer-readable memory of claim 29. Claim 29 is rejected for the same reasons that claims 1 and 15 are rejected.

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5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Takai et al., U.S. Patent No. 5,870,090, describes changing the size of a window and placing objects within the window at different positions for each window size at column 5 line 54- column 8 line 21.

Bogdan, U.S. Patent No. 5,977,966, Bogdan, U.S. Patent No. 5,903,265, Arigolas, U.S. Patent No. 5,815,151, and Ishida, U.S. Patent No. 5,684,969. All these references teach resizing windows.

***Allowable Subject Matter***

6. Claims 6-10 and 20-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record fails to teach or suggest designation means for designating fitting information to be fitted in the frame information and fitting means for fitting the fitting information designated by said designation means into a frame of the frame information or fails to teach or suggest the designation step of designating fitting information to be fitted in the frame information; and the fitting step of fitting the fitting information designated in the designation step into a frame of the frame information.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (703) 305-4723. The examiner can normally be reached on M-F from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (703) 305-4713.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

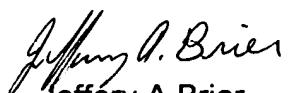
Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



Jeffery A Brier  
Primary Examiner  
Art Unit 2672